

Appl. No. 10/085,809
Attorney Docket No.: 98B014E
Amdt. dated January 5, 2006
Reply to Office Action of October 5, 2005

REMARKS/ARGUMENTS

Summary of the Invention

The present application is directed to processes and apparatuses for continuously separating polymer solids from a liquid medium comprising an inert diluent and unreacted monomers in a slurry polymerization process, as well as methods for converting a single loop reactor into multiple loop reactors.

Status of the Claims

Claims 1 through 28 are pending in the present application. Claims 1 through 6 and 26 through 28 were previously withdrawn from consideration. Claims 7 through 25 were rejected in the Office Action dated October 5, 2005.

Claim Rejections Under 35 USC §103(a)

Claims 7 through 25 have been rejected under §103(a) as allegedly being obvious in view of McElvain (WO 01/05842 A1) and Palmroos (WO 96/18662). The Office Action states that "McElvin is shown as providing a reactor with at least 8 vertical legs, [and] Palmroos is cited to teach the connection of multiple loop reactors in series." (Office Action at page 4.)

As previously stated by Applicants (and not refuted in the Office Action), these two references, when combined, do not include each and every limitation of the pending claims. Rather, the combination would result in redundant conduits and some loops having no discharge. For this reason alone, a *prima facie* case of obviousness has not been shown. Three separate requirements must be met to establish a *prima facie* case of obviousness: (1) there must be a suggestion or motivation to combine the cited references; (2) there must be a reasonable expectation of success; and (3) the references, when combined, must teach or suggest all of the claim limitations. MPEP §2143. When one of these requirements is absent, as here, obviousness cannot be shown. The arguments made in the Office Action that purport to establish the obviousness of the pending claims are directed not to the existence of all of the claim limitations in the cited references, but to the existence of a motivation to combine the references. Such arguments, which relate to the second prong of the obviousness requirement, do nothing to

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remedy the fact that the third prong is not satisfied.

Further, Applicants note that the Office Action alleges merely that the reactor configuration that results from the processes of the pending claims is found in the combination of the cited references. Even if the combined references taught the modified reactor combination, however, (and Applicants do not believe that to be the case) the currently pending claims are directed to a *process for converting* one reactor configuration into another. As such, the claims include steps of, for example, disconnecting and reconnecting conversion runs. Nowhere do the cited references teach or suggest these steps, either alone or in combination. Therefore, for this additional reason, the third prong of the obviousness requirement is not met and a *prima facie* case of obviousness has not been established.

Regarding the second prong of the obviousness requirement, sufficient motivation to combine the references has also not been established. The Office Action alleges that the motivation to combine the cited references, while not existing in the references themselves, may be derived from the "common knowledge" of those skilled in the art. (Office Action at page 4.) This assertion is insufficient to establish the requisite motivation. The motivation to combine references may come from one of three sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. MPEP §2143.01. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." *Id.* Further, with regard to the allegation of "common knowledge", as stated in the Office Action, there must be "some form of evidence in the record to support an assertion of common knowledge." MPEP §2144.03(B). "The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." *Id.* These requirements have not been met in the instant case and a sufficient motivation to combine the references has not been established. Accordingly, a *prima facie* case of obviousness does not exist. For all of the foregoing reasons, Applicants respectfully request that the claim rejections under §103(a) be withdrawn.

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CONCLUSION

In view of the foregoing remarks, Applicants believe that the pending claims are allowable and that the present case is in condition for allowance. Applicants invite the Examiner to telephone the undersigned attorney if there are any other issues outstanding which have not been presented to the Examiner's satisfaction.

Respectfully submitted,

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